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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/659,046	06/03/1996	PETER BAUER	8932-309	3843
20582	7590	06/15/2004	EXAMINER	
JONES DAY 51 Louisiana Avenue, N.W. WASHINGTON, DC 20001-2113			DEXTER, CLARK F	
		ART UNIT	PAPER NUMBER	
		3724		

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	08/659,046	BAUER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Clark F. Dexter	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 March 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 20,22-28,41-50 and 56-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 20,22-28,41-50 and 56-96 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachments(s)

- |                                                                                                                         |                                                                             |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.                                               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                         | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. The amendments filed January 16, 2004 and March 15, 2004 have been received, and the amendment filed March 15, 2004 has been entered.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

2. Claims 45, 69 and 89 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for first and second slots each defining a set of opposing surfaces wherein each set of opposing surfaces have beveled cutting edges facing in one direction. Rather, support is provided for the beveled edges of each set (as now defined) facing in opposite directions (e.g., see Figures 1a-c, 2a-c of the present application).

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

3. Claims 20, 22-28, 41-50, 56-58, 69 and 78-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 41, line 8, the recitation “at least one outer surface” renders the claim vague and indefinite, particularly since the slot is set forth as extending from the outer surface, and it seems that “at least one” in line 8 should be deleted.

In claim 45, line 2, the recitation “facing in one direction”, particularly in view of the amendment to the last paragraph of claim 41, renders the claim vague and indefinite as to what is being set forth and appears to be inaccurate.

In claim 69, line 2, the recitation “facing in one direction” renders the claim vague and indefinite as to what is being set forth and appears to be inaccurate.

In claim 78, lines 17-18, the recitation is vague and indefinite as to what is being set forth for numerous reasons including it is not clear as to what is meant by “the edge bounding the first slot”, the recitation “is non-parallel” is vague and indefinite as to relative to what the edge is non-parallel, and “the edges” lacks positive antecedent basis.

In claim 89, line 2, the recitation “facing in one direction” renders the claim vague and indefinite as to what is being set forth and appears to be inaccurate.

In claim 94, lines 2-3, the recitation is vague and indefinite as to what is being set forth for numerous reasons including it is not clear as to what is meant by “the edge bounding the second slot”, the recitation “is non-parallel” is vague and indefinite as to relative to what the edge is non-parallel, and “the edges” lacks positive antecedent basis.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 59-67, 70-74 and 77 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schofield, pn 955,287. Schofield discloses a cutting assembly with every structural limitation of the claimed invention including a first shearing element (e.g., 1) comprising a handle (e.g.,

3) and a head with a slot (e.g., 6), and a second shearing element (e.g., 2) comprising a handle (e.g., 4) and a head with a slot (e.g., 7), wherein the slot of each shearing element has opposing cutting edges (i.e., they face in opposite directions).

In the alternative, if it is argued that Schofield does not disclose tapered slots, the Examiner takes Official notice that it is old and well known in the art to at least slightly taper the slots to facilitate receiving the workpiece. Therefore, it would have been obvious to one having ordinary skill in the art to provide at least a slight taper to the slots of Schofield for the well known benefits including that described above.

Regarding claim 67, the relationship that the first shearing element is unconnected from the second shearing element is considered to be a functional recitation of intended use of the device of Schofield. That is, Schofield clearly discloses all of the claimed structure, and to merely disassemble the device of Schofield, or use components thereof prior to assembly, would merely amount to an alternate use of the structure disclosed by Schofield.

### ***Claim Rejections - 35 USC § 103***

7. Claims 20, 22, 25-27, 41-45, 47-49, 56-58, 59-65, 67-70, 72, 73, 75-84, 86-89, 91, 92 and 94-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papalardo, pn 3,885,307.

Papalardo discloses a cutting assembly with almost every structural limitation of the claimed invention including a first shearing element comprising a handle (e.g., 20) and a first head (e.g., 40) a claimed. Papalardo lacks a second shearing element.

However, the Examiner takes Official notice that it is old and well known in the art to provide multiple tools for various known reasons including for replacing one when the other becomes worn or otherwise damaged. It is respectfully emphasized that the claims are not drawn to a method/process. Therefore, the manner in which the two tools are used is considered to be a functional recitation of an intended use of the tool disclosed by Papalardo and thus cannot serve to distinguish the claimed invention over the Papalardo.

In the alternative regarding claim 59, if it is argued that Papalardo does not disclose a side surface with a portion that is substantially flat, the Examiner takes Official notice that it is old and well known in the art to make at least a small portion of peeling utensils with flat surfaces for various known benefits including for providing tool-resting positions or handle interface portions. Therefore, it would have been obvious to one having ordinary skill in the art to make a portion of the claimed surfaces substantially flat for the well known benefits including those described above.

***Allowable Subject Matter***

8. Claims 23, 24, 28, 46, 50, 85, 90 and 93 appear that they would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

9. Applicant's arguments with respect to the claims filed on January 16, 2004 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-1404. The examiner can be reached Monday through Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter  
Primary Examiner  
Art Unit 3724**

cfd  
June 12, 2004